



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/019,797

07/26/2002

Achim Gopferich

02592

1932

7590 04/22/2009
KENTON R. MULLINS
STOUT, UXA, BUYAN & MULLINS, LLP
4 VENTURE
SUITE 300
IRVINE, CA 92618

EXAMINER

SILVERMAN, ERIC E

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

04/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/019,797	Applicant(s) GOPFERICH ET AL.	
	Examiner ERIC E. SILVERMAN	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,9-33,36-38,41-44 and 63-66 is/are pending in the application.
- 4a) Of the above claim(s) 16-32 and 60-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,9-15,33,36-38 and 41-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The response filed 1/16/2009 was received. Claims 1-3, 5, 9-33, 36-38, 41-44, and 60-66 are pending. Applicants elected the species of second functional end-groups that are capable of being bound, but not bound, to substance d). Applicants submit that claims 1-3, 5, 9-33, 36-38, 41-44 and 63-66 read on this species.

Election/Restrictions

Newly submitted claims 65 and 66 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The originally elected and examined invention is a block copolymer. The invention of claims 65 and 66, while called a "population of molecules" in the preamble, is actually an array of block copolymers on the surface of a substrate.

Newly submitted claims 63 and 64 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The block copolymer in claim 64 cannot be the same as that of the examined invention. The block copolymer of claim 64 requires that both ends of b) are the same. b), in both the examined invention and these new claims, comprises a PEG. PEG has at least one hydroxyl end. Claim 1 requires that the other end, c2) is not hydroxyl. Thus, claim 1's block copolymer cannot have proximal and distal ends that are the same, as required by claim 64.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 65 and 66 are withdrawn from

Art Unit: 1618

consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Pursuant to Applicant's response, claims 16-32, 60-66 are withdrawn, and claims 1-3, 5, 9-15, 33, 36-38, and 41-44 are treated on the merits in this action.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 11, 14, 15 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,254,890 to Hirose et al. for reasons of record and those discussed below.

1. The claim amendments

The claims have been amended to require that c2) is not hydroxyl nor carboxylic acid. As explained in the diagram on page 8 of the 9/4/2008 office action, the moiety in Hirose corresponding to c2) is an amine. The ligand L in Hirose (corresponding to d) in instant claims) may or may not be present - c2) is a primary amine when it is not present. Note that the polymer of Hirose, before binding to L, is identical to the NH₂-PEG-PLA in the inventive examples, before the exemplified polymer is bound to the SWS (d) in the claims).

2. Applicants' arguments

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable features which he or she thinks the claims present in

Art Unit: 1618

view of the state of the art disclosed by the references cited or the objections made.

Further, they do not show how the amendments avoid such references or objections.

The arguments merely assert that the amendment overcomes at least some of the rejections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 9-15, 33, 36-38, and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,254,890 to Hirose in view of US 6,365,173 to Domb for reasons of record and those discussed below.

Response to Arguments

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable features which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. The arguments merely assert that the amendment overcomes at least some of the rejections.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1618

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC E. SILVERMAN whose telephone number is (571)272-5549. The examiner can normally be reached on Monday to Thursday 7:00 am to 5:00 pm and Friday 7:00 am to noon.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571 272 0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric E Silverman/
Examiner, Art Unit 1618